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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/841,595

04/25/2001

Koichi Motoike

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03/24/2003

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EXAMINER

WELLS, KENNETH B

ART UNIT

PAPER NUMBER

2816

DATE MAILED: 03/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/841,595

Applicant(s)

MOTOIKE, KOICHI

Examiner

Kenneth B. Wells

Art Unit

2816

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-20 is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2816

1. The amendment under 37 CFR 1.116 filed on 2/5/03 has now been entered in the RCE application. The arguments against the rejection based on Bohan Jr and Fisher are found to be persuasive and thus the previous rejections are now withdrawn. However, a new rejection based on Fisher is set forth below.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher.

Note Figs. 1 and 2, where the FET is transistor 12 and the inductor is element 17. The capacitor of claim 2 is capacitor 29, and the capacitor of claim 3 is capacitor 18. The limitations on the last five lines of claim 1, and the last four lines of claims 2 and 3, are deemed to be inherent, since all of the claimed structure is fully anticipated by the reference, see *In re Best*, 195 USPQ 430.

Art Unit: 2816

Not disclosed by Fisher is that value of inductor 17 is set in accordance with the voltage applied to gate G. This would have been obvious, however, to those having ordinary skill in the art who will of course choose a certain value for the inductor 17 (as opposed to randomly selecting any inductor "off the shelf"), and since the frequency of the signal which will be received at terminal G is known (i.e., predetermined) by the circuit designer, the recited limitation does not distinguish over the circuitry of Fisher.

As to claims 4-6, the recited control signal input circuit is any of the components, or the supply voltage generating circuitry (not shown), which applies potential to the drain of FET 12.

The limitations of claims 7-9 are deemed to be inherent, since all of the claimed structure is fully anticipated by the reference, see *In re Best*, 195 USPQ 430.

The bias supply circuit of claim 10 is voltage source 15.

3. Claims 11-20 are allowed.

4. Applicant's arguments filed on 2/5/03 have been fully considered but they are not persuasive.

Art Unit: 2816

The argument that in Fisher "the oscillation circuit including the inductor 17 connected between the source terminal of the FET 12 and the ground terminal" is not persuasive because this is exactly what the claims require. Thus, this argument is not understood.

The next argument, that "the controlled signal is not inputted to the gate terminal of the FET 12, and the signal corresponding to the controlled signal is not outputted from [sic] the drain terminal of the FET 12" is also not persuasive because again this is exactly what Fisher discloses (the controlled signal is the voltage applied to gate G, and the signal corresponding to this voltage is provided at drain D of FET 12).

The next argument, that "Fisher does not constitute part of a series resonance circuit and Fisher neither discloses nor suggests a series resonance circuit having the same configuration as that of the present invention" is not persuasive because (1) the circuitry of Fisher inherently will provide a series resonance circuit, and (2) it is not necessary that the reference have the same circuitry as that of applicant's *invention*, just applicant's claims.

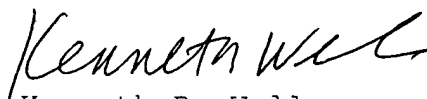
Art Unit: 2816

Finally, the argument that the inductance value of Fisher is not adjusted in accordance with the gate signal of FET 12 is not persuasive because the claims do not recite this, and instead only recite that the inductance is set in accordance with the signal applied to the gate of the FET (there is no "adjustment" of the inductance, i.e., it is fixed).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth B. Wells whose telephone number is 703-308-4809. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy P. Callahan, can be reached at 703-308-4876. The fax phone numbers for TC2800 are 703-872-9318 (before final) and 703-872-9319 (after final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 703-308-0956.



Kenneth B. Wells
Primary Examiner
Art Unit 2816

March 22, 2003